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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,029	07/30/2001	Frits Jacobus Fallaux	3833.5US	1408
24247	7590	03/24/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			NGUYEN, DAVE TRONG	
			ART UNIT	PAPER NUMBER
			1632	
DATE MAILED: 03/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notice of Allowability**

Application No.

09/918,029

Examiner

Dave T. Nguyen

Applicant(s)

FALLAUX ET AL.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to 01/19/04.
2. ☒ The allowed claim(s) is/are 1-9.
3. ☐ The drawings filed on 30 July 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☒ Certified copies of the priority documents have been received in Application No. 08/793,170.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____.   |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____  | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment         |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance   |
|  | 9 <input checked="" type="checkbox"/> Other 312 response.                  |

DAVE T. NGUYEN  
PRIMARY EXAMINER



818

<b>Response to Rule 312 Communication</b>	<b>Application No.</b> 09/918,029	<b>Applicant(s)</b> FALLAUX ET AL.	
	<b>Examiner</b> Dave T. Nguyen	<b>Art Unit</b> 1632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The amendment filed on 19 January 2004 under 37 CFR 1.312 has been considered, and has been:

- a) ☐ entered.
- b) ☐ entered as directed to matters of form not affecting the scope of the invention.
- c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.

- d) ☒ disapproved. See explanation below.
- e) ☐ entered in part. See explanation below.

*The 312 amendment changes the breadth of the claims by not only adding new claims directed to a different scope, but also by claiming the invention as a product by process, which issue regarding the product by process had already been excluded by the action of the examiner's amendment of record. Thus, the 312 amendment is not entered. However, during a review of the claims and subsequent telephone conversations with attorney Scott Dorland, particularly on March 2, 2004, the examiner indicates to applicant that while the 312 amendment is disapproved, claim 1 should be clarified to indicate that the claimed recombinant nucleic acid molecule - can be acted on by the action of a nucleic acid polymerase - rather than the current phrase "can produced by the action of a nucleic acid polymerase". The examiner further agreed with applicant that by currently claiming that the recombinant nucleic acid molecule "comprises, at the molecule's 3' terminus, a recombinantly fused sequence complementary to an upstream part of the same strand of the molecule", thereby having a hairpin loop, the claimed recombinant nucleic acid should be recited as being - essentially single stranded form -. Thus, in order to more clearly clarify that the the claimed recombinant nucleic acid can be acted on by a nucleic acid polymerase and is "essentially single stranded form" due to the presence of the hairpin loop in the claim, a supplemental examiner's amendment is attached to this 312 response. This supplemental examiner's amendment does not change the breadth of the claims, and thus, is merely intended to more clearly clarify the structural limitations which were already present in the claims prior to this amendment.*

Art Unit: 1632

### **Supplemental Examiner's Amendment**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Attorney Scott Dorland on March 2, 2004.

Claims 1 has been amended as follows:

1. (currently amended) A recombinant nucleic acid molecule that can be acted on [produced] by [the action of] a nucleic acid polymerase in a complementing cell comprising at least the E1A gene of an adenovirus [on a precursor molecule]; wherein  
said recombinant nucleic acid molecule is a nucleic acid molecule based on or derived from an adenovirus,  
said recombinant nucleic acid molecule has at least one functional inverted terminal repeat,  
said recombinant nucleic acid molecule comprises all other adenovirus derived genetic information not present in said complementing cell and necessary for replication, and  
said recombinant nucleic acid molecule is in a linear and essentially single stranded form and comprises, at the molecule's 3' terminus, a recombinantly fused

Art Unit: 1632

sequence complementary to an upstream part of the same strand of the recombinant nucleic acid molecule, to allow said recombinantly fused sequence and said upstream part to form base pairs and function as a start-site for said nucleic acid polymerase.

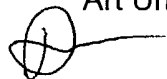
Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **571-272-0731**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Amy Nelson*, may be reached at **571-272-0184**.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center number, which is **703-872-9306**.

Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is **(703) 308-0196**.

Dave Nguyen  
Primary Examiner  
Art Unit: 1632



DAVE T. NGUYEN  
PRIMARY EXAMINER